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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 18

Application Number: 08/626,600

Filing Date: April 2, 1996

Appellant(s): Michael F. Quinn, James McGinlay, Roman Kadron

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Group 2700

George T. Marcou
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed November 25, 1998.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

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A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1 - 12 and 14 - 32 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in Appendix II to the brief is correct and reflects entry of the amendment filed under 37 C.F.R. § 1.116 on November 25, 1998.

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(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,490,217	Wang et al.	2-1996
5,168,444	Cukor et al.	12-1992

Dysart, J. "A Shortcut in the Paper Chase", Distributing, vol. 93, no. 1, (January, 1994), pp 42 - 44.

Reding, T. "Digital Imaging Technology: What, Where, and Why in Commercial Nuclear Power", Nuclear Plant Journal, vol. 9, no. 4, (July-August, 1991, pp 89, 90, & 94.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1 - 12 and 14 - 32 are rejected under 35 U.S.C. § 103. This rejection is set forth in prior Office action, Paper No. 12. The rejection of Claim 28 under 35 U.S.C. § 112 has been withdrawn by the Examiner for the reasons presented below.

(11) Response to Argument

(A) Response to Applicants' Proposed Amendment

1. Applicants filed a proposed amendment under 37 C.F.R. § 1.116 contemporaneously with the filing of an Appeal Brief herein. The proposed amendment makes minor corrections to the

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claims that will reduce antecedent basis issues for appeal and therefore, will be entered with the following two corrections:

(A) The insertion of --data-- at line 26 of Claim 1 will be done after the second "transaction".

(B) The insertion of --transaction-- at line 3 of Claim 5 will be done after the second "the".

The claims presented in Appendix II of Applicants' Appeal Brief reflect the above corrections.

(B) *Response to Applicants' Remarks*

2. The Examiner responds below to Applicants' traversals in their November 25, 1998 Appeal Brief. The issues presented below generally match the sequence of issues raised by Applicants.

3. As regards the grouping of claims, the Examiner agrees with Applicants that the rejection of claims under 35 U.S.C. § 103 in view of Cukor and Reding should be for Claims 1 - 12, 14 - 25, 27 - 29, and 32 (and not Claims 1 - 12 and 14 - 32 as listed at paragraph 14 of the prior May 27, 1998 Final Office Action). The Examiner apologizes to Applicants for any confusion caused by this error.

4. The Examiner has reviewed the Specification regarding support for Claim 28 and concurs with Applicants that sufficient support exists in the Specification for this claim (see Specification

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at page 6, lines 5 - 26 and page 13, line 23 - page 14, line 6, for example). Therefore, the rejection of Claim 28 under 35 U.S.C. § 112 is hereby withdrawn.

5. As regards the reference to Claim 1 within the rejection of Claim 31, the Examiner notes that Claim 31 depends on Claim 23. Claim 23 was rejected, in part, based on the reasoning presented regarding Claim 1 as regards similar subject matter in the two claims. Since, by its dependency, Claim 31 includes the limitations of Claim 23, which in turn recites subject matter similar to Claim 1, the rejection of Claim 31 incorporated the analysis for the prior rejections of Claims 1 and 23.

6. As regards Fig 1 of Cukor failing to show a plurality of regional centers networked together, the Examiner notes that Fig 1 is presented in Cukor as being representative of the claimed document management system, which may include a plurality of regional centers in communication with each other (Cukor at Fig 1; Col 4, lines 25 - 26; Col 5, line 63 - Col 6, line 6; Col 22, lines 19 - 44). Similarly, the present application, which discloses and claims one or more regional processing centers (Claim 1; Specification at page 3, lines 21 - 25), discloses at Fig 1 a single regional processing center that is representative of its document management system (see Specification at page 8, lines 12 - 13). Notably, the detailed description of the invention discloses processing involving a single regional processing center (Specification at page 13, lines 20 - 22;

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page 14, lines 7 - 16). Therefore, the Examiner respectfully asserts, Cukor discloses as much as does Applicant's disclosure. *In re Epstein*, 31 USPQ2d 1817, 1823 (CAFC 1994) (rejecting applicant's argument that the § 103 references must contain more detail than applicant has disclosed).

7. The Examiner agrees with Applicants that Cukor fails to recite a "plurality of 'image processing centers 12' coupled together over a 'large geographical area'". However, none of the prior office actions ever asserted such a feature. Instead, the Examiner asserted at paragraph 14(A) of the prior office action that, while Cukor does not expressly disclose use of a wide area network for connecting the workstations to the regional center nor for linking regional centers to each other, it does teach that a plurality of such regional centers may be networked together over a large geographic area. See Cukor at Col 5, lines 52 - 59. Cukor additionally discloses the use of Tandem MULTILAN software to interconnect the workstation/processing center LAN's together for connection to a central server. Although the term, "wide area network" was not utilized in Cukor, the Reding reference clearly teaches the use of such networks across an enterprise for document scanning, management, and retrieval (see Reding at page 89, columns 1 - 2). The motivation to combine the teachings of the references was found in both references -- namely to provide for institution-wide storage and retrieval of documents (see Reding at page 90, col 3; Cukor at Col 5, lines 52 - 59).

8. As regards the Examiner's alleged contradiction regarding storage of customer's messages, the Examiner asserts, as stated at paragraph 14(A) of the prior office action, that Cukor

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discloses means for storing messages and inquiries at Col 21, line 13 - Col 22, line 11. However, Claim 1 recites such storage means to be part of "customer service units". Furthermore, the Specification identified the messages as being originated and accessed by users (customers) (Specification at page 22, line 21 - page 24, line 14). Therefore, while Cukor failed to expressly teach that the messages and inquiries being stored were customer messages and inquiries, the Examiner asserted that it would have been obvious to one of ordinary skill in the art of financial information management to include means for storing customer messages and inquiries. One would be motivated to do so in order to retain all information related to a particular transaction in a single, searchable database for subsequent review and/or retrieval and to avoid the problems associated with handling paper documents. This motivation comes directly from the Cukor reference at Col 1, line 65 - Col 2, line 21; Col 3, lines 19 - 30; Col 3, line 56 - Col 4, line 19.

9. As regards Cukor being limited to bills of lading documents, the Examiner respectfully asserts that Cukor discloses managing all documents associated with shipments of goods, including waybills, delivery receipts, and purchase orders (Col 1, lines 6 - 10; Col 1, line 66 - Col 2, line 1; Col 10, lines 32 - 34).

10. As regards Applicants' remarks regarding the "header" of Cukor, the Examiner respectfully asserts that nowhere in the prior office actions was the "header" of Cukor referenced or relied upon.

11. As regards Applicants' remarks regarding the disclosed detail of managing messages and inquiries, the Examiner respectfully notes that what is claimed regarding this matter is "... means

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for storing transaction data folders which contain bit mapped images and messages and completed inquiries". Such means are disclosed by Cukor at Col 5, lines 31 - 59; Col 10, lines 22 - 40; and Col 21, line 13 - Col 22, line 11. Whether or not additional detail is disclosed in the Specification regarding additional management of messages and inquiries, such detail is not necessarily read into the claims during prosecution. *In re Zeltz*, 13 USPQ2d 1320, 1321 - 22 (CAFC 1989) (noting that claims are given the broadest reasonable interpretation consistent with the specification -- while claims are read in light of the specification, specification limitations are not read into claims).

12. As regards the contents of the electronic folder, Cukor discloses (1) bit mapped images at Col 5, lines 31 - 50; Col 21, lines 24 - 25; (2) information about the bit mapped (scanned) images at Col 21, lines 15 - 26; (3) messages at Col 21, lines 13 - 20; and (4) completed inquiries at Col 21, lines 15 - 27). Additionally, Reding was introduced to disclose ASCII information about bit mapped (scanned) images at page 89, column 2.

13. As regards indexing, Cukor discloses the practice of indexing all documents related to a transaction with a unique PRO number (Cukor at Col 2, lines 7 - 22). No reference is made in the prior office action regarding Cukor's "header" information.

14. As regards the supervisory features of Claim 4, the Examiner notes that such monitoring and privilege functions were asserted by the Examiner in the October 27, 1997 Office Action to be well known. This assertion was not traversed by Applicants in their subsequent, February 27, 1998 response/amendment; and, therefore, is deemed admitted. See MPEP § 2144.03.

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15. As regards the distinction Applicants' attempt to make regarding Cukor's alleged disk file versus the application's claimed transaction folder, the Examiner asserts Cukor and the present application disclose these relative elements to have dual characteristics of form and function. Cukor's file is clearly disclosed to reside on one or more physical storage disks (Cukor at Figs 1 - 3; Col 5, line 63 - Col 6, line 10; Col 10, lines 46 - 51). Similarly, the application's claimed transaction data folder is physically located on electronic storage media (Fig 2 (detail 170) and Specification at page 3, lines 12 - 25; page 12, lines 4 - 24). Cukor's data files also have the functional feature of linking together all images, documents, and messages associated with a particular transaction (Cukor at Col 3, lines 23 - 30; Col 5, lines 43 - 47; Col 6, lines 33 - 37; Col 15, lines 2 - 8). Such features are analogous to those disclosed for the application's transaction folders (Specification at page 12, lines 11 - 24). As regards the alleged lack of structure of Cukor's files, the Examiner respectfully cites to Col 13, line 60 - Col 15, line 8 and Col 18, lines 49 - 68 for disclosing Cukor's structured, database files supporting its document management system.

16. Claim 6 recites "... means for assigning a transaction data folder to a particular user based upon a predetermined routing procedure." Cukor clearly discloses a procedure for assigning a data folder (file) to a user at Col 6, lines 49 - 60 and Col 10, lines 22 - 40. Whether Cukor discloses a manual procedure or an automated process for assigning a file to a user does

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not negate the obviousness of providing such an assignment procedure in view of Cukor. *In re Venner*, 120 U.S.P.Q. 192, 194 (CCPA 1958). (noting that it is not "invention" to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result).

17. As regards the alleged small amount of storage provided by Cukor, the Examiner respectfully asserts that, in the absence of any claim recitation regarding the size or capacity of the invention's transaction data folders, the size of Cukor's admitted local storage files is irrelevant. As regards Cukor's local storage merely being a buffer, the Examiner cites to Cukor at Col 7, lines 21 - 25; Col 10, line 22 - Col 11, line 9 for disclosing the storage of document images and information in local disk storage.

18. As regards Reding failing to disclose "how to arrive at the claimed invention", the Examiner notes that Cukor was relied upon to disclose the substance of Applicants' invention, with Reding introduced to further support the use of geographically diverse networks known as wide area networks in document management systems. As regards the Cukor/Reding combination, the Examiner notes that combining of references to show the obviousness of an invention is permissible under 35 U.S.C. § 103 if the references teach in analogous art. *In re Gorman*, 18 USPQ2d 1885, 1888 (CAFC 1991). Here, both Cukor and Reding teach in the art of document management systems (Cukor at abstract; Reding at page 89, columns 1 - 2). Additionally, under 35 U.S.C. § 103, there must be a reason, suggestion, or motivation to make the combination. Such a suggestion may come from the references themselves, from certain

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references known to those skilled in the art, or from the nature of the problem to be solved. *Pro-Mold and Tool Co. v. Great Lakes Plastics, Inc.*, 37 USPQ2d 1626, 1629-30 (CAFC 1996). The motivation to combine the teachings of the references was found in both references -- namely to provide for institution-wide storage and retrieval of documents (see Reding at page 90, col 3; Cukor at Col 5, lines 52 - 59). See paragraph 14(A) of the prior office action.

19. As regards the Wang reference failing to teach transaction folders, the Examiner notes that Cukor was relied upon for this feature, and Wang was introduced to show the obviousness of document addition and copying within a document management system.

20. As regards the limitations of Claim 26 over the teachings of Wang, Applicants have admitted that two reasonable interpretations of Wang are that it discloses either adding a document to a file or adding information to a file. The Examiner respectfully asserts that either interpretation reads on Claim 26. Claim 26, reciting the transaction folder to be pre-existing, depends ultimately from Claim 23. Claim 23 broadly recites the limitation that the "transaction folder contains information related to said financial transaction including said at least one bit mapped image and said messages." Therefore, the Examiner asserts, whether Wang is interpreted to disclose adding an entire document to a file or merely adding information to the file, this reference reads directly on the limitation of independent Claim 23 as modified by Claim 26 that recites "information related to said financial transaction" being contained within the transaction folder.

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21. Whether or not Wang teaches copying a document to a second folder and deleting the first folder is irrelevant because no such feature is claimed.

22. The motivation to combine the addition/update features of Wang to the document management system of Cukor, is to maintain documents accurately and easily within an automated document handling system. This motivation is provided by Wang itself (Wang at Col 1, lines 21 - 25).


23. Applicants' remaining traversals are discussed under the 35 U.S.C. § 103 rejection of the prior, May 27, 1998, office action.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

WNH

December 24, 1998 WNH


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